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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,751	01/29/2001	Masayuki Chatani	375.16.01	8559
25920	7590	02/27/2006	EXAMINER	
MARTINE PENILLA & GENCARELLA, LLP 710 LAKEWAY DRIVE SUITE 200 SUNNYVALE, CA 94085			EL HADY, NABIL M	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/771,751	CHATANI, MASAYUKI	
	Examiner	Art Unit	
	Nabil M. El-Hady	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/18/05, 12/5/05</u> | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-26 are presented for examination. Claim 25 is canceled. Claims 1-24 and 26 are presented for examination.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-24 and 26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over allowed claims 1-10, 12-19, 22-25, and 29-39 of U.S.

Application 09/452,811, hereinafter "811". Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and "811" discloses system and method for providing selected auxiliary content stored in a local storage at a client during download of primary content from a server, the selection is based on analysis of user information downloaded to the client in response to uploading user identification to the server. Limitations in claims 1-24 and 26 in the instant application is the same or combination of the limitations in claims 1-10, 12-19, 22-25, and 29-39 in "811".

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4. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following has no antecedent basis:

a) "the requested primary content", claim 1, lines 16-17.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 19, 20, and 22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Landsman et al. (US 6,314,451), hereinafter "Landsman".

7. Landsman is cited by the examiner in a previous office action.

8. As to claim 19, Landsman discloses a method for providing auxiliary content from a local storage device during download of primary content from a server network over a bi-directional communications network (col. 4, lines 35-47; and col. 11, lines 3-12), comprising establishing a communications link between a client console and a download management server that is part of the server network through the bi-directional communications network (col. 6, lines 20-28,30-37); the client console having the local storage device installed therein (col. 4, lines 36-39); transmitting user identifier data contained on said local storage device and a request for predetermined primary content to the download management server (col. 5, lines 21-26), in

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order to retrieve said primary content from the download management server (col. 6, lines 20-32); accessing the auxiliary content stored on the local storage device during download of the primary content to the client console (col. 4, lines 43-47); selecting the auxiliary content to be accessed by the client console based on user information obtained by examining the transmitted user identifier, the user information comprising preferences provided by either the client or a distributor of the primary content (col. 5, lines 21-26; and col. 6, lines 28-41).

9. As per claim 20, the claim is rejected for the same reasons as claim 19 above.

10. As per claim 22, the claim is rejected for the same reasons as claim 19 above.

11. Claims 1, 2, 4-13, 15, 17, 18, 21, 23, 24, and 26 are rejected under 35 U.S.C. 103(a) as obvious over Landsman in view of Applicant Admitted Prior Art, hereinafter "AAPA".

12. As to claim 1, the claim is rejected for the same reasons as claim 19 above. In addition, Landsman discloses the user identifier is uploaded from the client console to the download management server (col. 5, lines 21-26), the user identifier being used to enable access a predetermined primary content in the primary content database (col. 10, lines 32-35), and specific portions of the auxiliary content stored in the local storage device is played by the client console during downloading of the requested primary content (col. 10, lines 32-35). Landsman does not specifically disclose the specific portions of the auxiliary content being selected for play at the client console during download based on analysis of the user information that was downloaded to the client console in response to the uploading of the user identifier to the download management server. AAPA, however, discloses that advertisement played to the

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client is based on client identifying information (AAPA, spec. p3, customer view attached advertisements which may be targeted to the customer based on his or her identifying information), and may be selected based on user information (AAPA, spec. p4, lines 15-16). It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Landsman and AAPA in order to feed the client with the specific or selected ads that fit her or her identifying information.

13. As to claim 2, Landsman discloses the auxiliary content is variable based on a user preference (col. 9, lines 55-63).

14. As to claim 4, Landsman discloses the auxiliary content is variable based on a distributor preference (col. 4, lines 43-52).

15. As to claim 5, Landsman discloses the distributor preference is determined first by having the download management server send the client preference data usable to assign content before sending the requested content, and second by having the client console execute the content stored in the local storage according to the preference data (col. 10, lines 1-12).

16. As to claim 6, Landsman discloses the preference data can be selected from one or more individual content choices and one or more content category choices (col. 10, lines 33-46).

17. As to claim 7, Landsman discloses the auxiliary content can be acquired and distributed to the local storage over the communications network (col. 10, lines 46-55).

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18. As to claim 8, Landsman teaches the system, wherein the local storage is a hard disk drive (e.g. col. 10, lines 43-45).

19. As to claim 9, Landsman discloses the client console further comprises a local fixed storage disposed internally or externally of the client, wherein requested primary content is downloaded onto the fixed storage device (e.g. col. 10, lines 5-12).

20. As to claims 10-13, AAPA discloses the auxiliary content is provided on portable or removable storage that stores the auxiliary content and is suitable for mass distribution (spec. p4, lines 13-15). It would have been obvious to one skilled in the art at the time of the invention that portable storage may be CD ROM and that these CD ROMs are distributed to customers by any type of mass distribution including direct mail or placed in purchased printed products.

21. As to claim 15, the claim is rejected for the same reasons as claims 1 and 19 above. In addition, it is inherent in AAPA's disclosure (AAPA, spec. p3, customer view attached advertisements which may be targeted to the customer based on his or her identifying information) that if advertisement played to the client is based on client identifying information, then some sort of comparison is being performed between user information and the auxiliary content in order to trigger execution of specific portions of the auxiliary content.

22. As to claim 17, Landsman teaches the system wherein the auxiliary content is selected from the group consisting of images, movies, music, games, customer surveys and lots (e.g. col. 10, lines 1-10).

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23. As to claim 18, Landsman teaches the system wherein information is downloaded from the download management server into the client console to trigger execution of specified auxiliary content items based on comparison with the information (e.g. col. 10, lines 33-46).

24. As to claim 21, the claim is rejected for the same reasons as claims 1 and 19 above. In addition, it is inherent in AAPA's disclosure (AAPA, spec. p3, customer view attached advertisements which may be targeted to the customer based on his or her identifying information) that if advertisement played to the client is based on client identifying information, then some sort of comparison is being performed between user information and the auxiliary content.

25. As to claim 23, the claim is rejected for the same reasons as claims 1, 19, 21 above. In addition, AAPA discloses determining whether a control function of the client console is enabled for permitting viewing of the auxiliary content (spec. p4, lines 6-9).

26. As to claim 24, Landsman discloses continuously surveying to determine whether the client console user overrides playback of said auxiliary content during execution of said primary content (col. 10, lines 33-46).

27. As to claim 26, the claim is rejected for the same reasons as claims 1, 19, and 23 above.

28. Claims 3,14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman in view of AAPA and further in view of Rakavy et al. (US 5,913,040) (hereinafter Rakavy).

29. Rakavy is cited by the examiner in a previous office action.

30. As to claim 3, Landsman and AAPA do not specifically disclose the client preference is determined by prompting the client to input information settings, and by providing the client with a selection of one or more individual content choices and one or more content category choices. Rakavy, on the other hand, discloses the client preference is determined by prompting the client to input information settings, and by providing the client with a selection of one or more individual content choices and one or more content category choices (col. 3, lines 34-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Landsman, AAPA, and Rakavy in order to add interactivity between the client and the server for the purpose of information collection.

31. As to claims 14 and 16, Landsman does not specifically disclose said removable storage device includes data structures thereon comprising a plurality of auxiliary content items, a plurality of trigger data items logically associated, respectively, with each of said auxiliary content items, and a user identifier. Rakavy, on the other hand, discloses said removable storage device includes data structures thereon comprising a plurality of auxiliary content items, a plurality of trigger data items logically associated, respectively, with each of said auxiliary content items, and a user identifier (e.g. col. 10, lines 21-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Landsman, AAPA with Rakavy in order to allow the user to select specific ads. .

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32. Applicant's arguments filed 12/8/2005 have been fully considered but they are not persuasive. The rejection of claims 1-24 and 26 is maintained.

33. In the remarks, applicants argued in substance that in Landsman (1), based on a user's profile, specific ads are sent to the user and all are played, there is no need to identify specific portions to play back to the user, (2) playback to the user occurs during times of no interaction not during downloading of predetermined primary content.

34. Examiner respectfully traverses applicants' remarks.

35. As to point (1), applicant is referred to the above rejection. In addition, AAPA discloses that ads displayed on the local computer can be selected based on pre-configured user preference information (spec. p4, lines 15-16). Rakavy, also discloses allowing the user to select from a variety of ads according to user preferences (col. 3, lines 2-3, 34-37).

36. As to point (2), applicant is referred to the above rejections. In addition, Landsman discloses the ads are displayed in an interval of time that occurs after a user has clicked on a hot-link to retrieve a desired content but before that the browser has started rendering the content, which is interpreted by examiner as during the downloading of the content. Also Rakavy discloses that other techniques for displaying the ads, other than using the idle time, may be used (col. 3, lines 26-32), which may include any control function to trigger the display (see, for example, AAPA, spec., p4, lines 6-9).

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37. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M. El-Hady whose telephone number is (571) 272-3963. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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February 21, 2006

A handwritten signature in black ink, appearing to read "N. El-Hady". The signature is fluid and cursive, with a long, sweeping line extending downwards from the end of the name.

Nabil El-Hady, Ph.D., M.B.A.
Primary patent Examiner
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